

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 1-7 and 9 are rejected under 35 U.S.C. 103(a) over the patent to Jares in view of the German patent document to Weber and the Great Britian document to Minamidate.

Claim 8 is rejected as above and further in view of the U.S. patent to Radle.

Also, claim 1 is rejected under 35 U.S.C. 112.

In connection with the Examiner's rejection of the claims, applicants have amended claim 1, the broadest claim on file, and added the second independent claim 10.

It is respectfully submitted that the new features of the present invention which are now defined in claims 1 are not disclosed in the references and can not be derived from them as a matter of obviousness.

Claim 1 defines a hand power tool with the safety element which is movable to avoid transmission of vibrations through the safety element during a predeterminable operation.

The patents to Jares and Weber disclose devices which do not have a safety element. The patent to Minamidate discloses a handle with a tie-rod 3. The tie-rod has the purpose to transmit vibrations from the vibration receiving member 1 to the second vibration-damping body 4, as agreed by the Examiner in the previous Office Action.

In contrast, the safety element in accordance with the present invention is movable to avoid transmission of vibrations through the safety element. The tie-rod disclosed in the patent Minamidate can not be movable in the sense not to transmit vibrations. The invention disclosed in the patent to Minamidate is very clear in this point. At page 2, line 35-40 it reads: "The vibration ...will then be transmitted via the tie-rod 3 to the second vibration-damping body 4". It clearly means that in the patent to Minamidate all vibrations are transmitted from the vibration receiving member 1 to the second vibration-damping body 4. Applicants have never provided any statements to the contrary.

The purpose of the tie-rod 3 is unquestionably the transmission of vibrations. Therefore, the tie-rod can not be constructed in such a way that it avoids transmission of vibrations. Otherwise, it would not follow the invention disclosed in the patent to Minamide. The patent to Minamide teaches away from the new features of the present invention.

In connection with this, the Examiner's attention is respectfully directed to some decisions. In particular, in the decision of the Patent Office Board of Appeals, *in re case ex parte Tanaka, Marashima and Takahashi* (174 USPQ 38) it was stated:

"Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewrite prior art devices in order to accomplish applicant's results since there is no suggestion in the prior art that such a result could be accomplished by some modifying prior art devices".

This decision is clearly applicable in this case.

It is believed therefore that the patent to Minamide does not teach the new features of the present invention.

The same is true with respect to the combination of the references, in particular the teachings of the patent to Jares to Weber and

to Minamidate. Any hypothetical construction produced from such a combination would be different from the applicant's invention.

The Examiner indicated in the Final Office Action that the tie - rod does only transmit a part of the vibrations. If the handle of claim 1 would eliminate all possible vibrations the Examiner requested evidence in the specification as to how this is possible.

Claim 1 does not define a handle, but instead it defines that the safety element is constructed to avoid transmission of vibrations through the safety element. The handle altogether does of course transmit some vibrations. Vibrations are transmitted from the mounting element to the gripping part by the elastic element which connects the gripping part to the mounting element. However, the construction of the safety element is such that it avoids transmission through the safety element. It is believed that from the specification it is easy to understand that for example a slack rope or movable spring surrounded by the vibration damping body are constructed to avoid transmission of vibrations.

It is therefore believed that claim 1 should be considered as patentably distinguishing over the art and should be allowed.

The Examiner's attention is respectfully directed to the features of some claims. Claim 4 defines that the safety element is formed as a rigid component which is connected through the elastic element with the gripping part and the mounting part. This means that the safety element does neither attach the gripping part nor the mounting part, but it is connected to those parts via the elastic element. The elastic element holds the safety element in place, as shown in Figures 3 and 4.

In the patent to Minamidate the tie-rod 3 is mounted directly to the mounting part which is called receiving member 1. The tie-rod is not connected to the receiving member via the elastic element. The same is true for the connection of the tie-rod with the gripping part 6 which is done by means of two screws 5a, 5b. Again, the tie rod is not connected to the gripping part via the elastic element. It is therefore believed that claim 4 should be considered as patentably distinguishing over the art since it defines the features which are patentable per se.

Claim 7 defines a hand tool in which the safety element is loaded by pulling. The patent to Minamidate is silent about any pulling of the tie-rod. It is therefore believed that such pulling is not disclosed in the patent to Minamidate and claim 7 should also be considered as patentably

distinguishing over the art per se.

Claim 9 defines a safety element determining a maximum deviation of the elastic element from a base position in a tilting direction. Such maximum deviation can not be derived from the tie-rod 3 of the patent to Minamide in a handle of Weber. Such handle with tie rod can be bent as far as the handle is pushed by an external force. The elastic element does not determine any maximum deviation. Therefore, claim 9 should also be considered as patentably distinguishing over the art and should be allowed.

Claim 10 defines a hand power tool with a mounting part, a handle with a gripping part having a mounting side facing toward the mounting part and a safety element which is fixed at the mounting side, connecting the mounting side with the mounting part. The patent to Weber does not disclose a safety element. The patent to Minamide discloses a handle with a tie-rod. The tie-rod is not a safety element, but is a completely different part which serves for transmission of vibrations and not for providing any safety. It is believed that a person of ordinary skill in the art would not combine the patent to Minamide with the patents to Weber and Jares and integrate a complete different part with completely different purposes as a

safety element in the patent to Weber. Therefore the present invention as defined in claim 10 can not be considered as rejectable over the combination of the references.

Even if for some unknown and highly improbable reason a person skilled in the art combined the teaching of the patent to Jares with the teachings of the patent to Weber and Minamidate, he would follow the teaching in the patent to Minamidate and the patent to Weber (page 6, paragraph 2) that the metal core 10 has a purpose not to follow (Weber) or even counteract (Minamidate) the vibrations going out from the plate 6 in the patent to Weber respectively the vibration receiving member 1 in the patent to Minamidate. A person skilled in the art would therefore construct a tie-rod as in the patent to Minamidate to a handle as in the patent to Weber, so that such a rod would transmit vibrations from the plate 6 to the metal core 10 to make the metal core counter vibrate as suggested in the patent to Minamidate. Such a construction does only work and build up counter vibrations crosswise to the axis of the handle, if a metal core serving as the second vibration damping body is at the rear end of the handle or at least spaced apart in the direction to the end of the handle from a third vibration damping body which is connected to the elastic element (Minamidate, page 2, left column, lines 13-57 in Figure 1).

In a combination of the teachings of the patents to Minamidate and Weber, a tie-rod would therefore extend from the plate 6 to some vibration damping body not placed at the mounting side of the handle in the patent to Weber. Otherwise, the effect described in the patent to Minamidate would not take place and any combination would not make any sense. Therefore, any safety element can not be fixed at the mounting side of the handle as in the patent to Weber, connecting the mounting side with the mounting part.

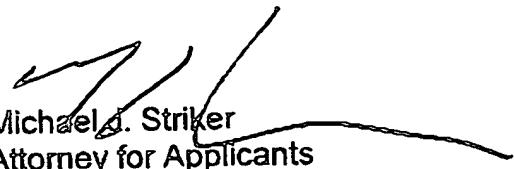
It is therefore believed that the new features of the present invention which are now defined in claim 10 are also not disclosed in the references and can not be derived from them as a matter of obviousness. Claim 10 should be considered as patentably distinguishing over the art and should be allowed.

As for the other dependent claims, these claims depend on claim 1, they share its presumably allowable features, and therefore it is respectfully submitted that they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



Michael J. Striker  
Attorney for Applicants  
Reg. No. 27233